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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/801,078	03/15/2004	Krzysztof Palczewski	029060-000200US	9475
70680	7590	11/05/2010		
Patentique PLLC P.O. Box 50368 Bellevue, WA 98015			EXAMINER HUANG, GIGI GEORGIANA	
			ART UNIT 1617	PAPER NUMBER
			MAIL DATE 11/05/2010	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

**Advisory Action
Before the Filing of an Appeal Brief**

Application No.

10/801,078

Applicant(s)

PALCZEWSKI ET AL.

Examiner

GIGI HUANG

Art Unit

1617

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 19 October 2010 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☐ The period for reply expires _____ months from the mailing date of the final rejection.
b) ☒ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.
Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☒ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because:
(a) ☒ They raise new issues that would require further consideration and/or search (see NOTE below);
(b) ☐ They raise the issue of new matter (see NOTE below);
(c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: See Continuation Sheet (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☐ Applicant's reply has overcome the following rejection(s): _____.
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☒ For purposes of appeal, the proposed amendment(s): a) ☒ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
The status of the claim(s) is (or will be) as follows:
Claim(s) allowed: _____.
Claim(s) objected to: _____.
Claim(s) rejected: 52-71.
Claim(s) withdrawn from consideration: _____.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing a good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because: See Continuation Sheet.
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08) Paper No(s). _____.
13. ☐ Other: _____.

/Zohreh A Fay/
Primary Examiner, Art Unit 1627

Continuation of 3. NOTE: The newly amended claims change the scope of the examined claims and require a new search and consideration. They now recite a single specific retinoid of 9-cis-12-methyl retinal to be the only retinoid for the recited method of treatment where the scope of the examined claims were substantially broader and did not require the retinoid to be the 9-cis-12-methyl retinal as recited by the newly amended claims.

Continuation of 11. does NOT place the application in condition for allowance because: Applicant's arguments are in regards to the newly amended claims which are not entered. In regards to Applicant's assertion that there is no new issue for search or consideration as the compound of 9-cis-12-methyl-retinal was indicated as enabled in the previous action asserting that the subject matter has been searched and examined.

This is not persuasive nor accurate.

As addressed in the interview summary of the interview of 10/5/2010, Applicant had been allowed to switch the elected species at RCE as a courtesy on 7/27/2009 when asked in the interview of 10/5/48612 on 4/8/2009 to allow a switch to the 9-cis retinoid form of the claims, wherein it is then the prerogative of the Examiner to choose the compound from the genus for examination or to ask for an election of species.

The Examiner proceeded to assist the attorney of record to correct the specification to rectify the structural error in the specification based on the examples in the specification to not enter new matter to the specification.

The examined claims were broad and did not have a claim that only recited only the single specific compound for examination of 9-cis-12-methyl retinal. It only recited a particular structure-claim 53, where a scope of enablement was addressed to identify what was enabled but the claims were broad and the art rejection of record goes to the two fluorinated compounds such as 9-cis-10F-retinal which was chosen by the Examiner (in lieu of an additional election of species as a result of amended/newly submitted claims by Applicant), and the two fluorinated compounds in the examination and the art rejection are encompassed by the scope of the examined claims but are excluded by the newly amended claims wherein by definition, changes the scope of the claims as written wherein a new search and further consideration is required and prosecution is closed.